

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Ex Parte: SANDERS III, STEPHEN HAROLD
Application Number: 10/052,800
Filing Date: October 29, 2001
Title: Service Management Agent For Managing
the Provision of Different Services to a
Communication Device

Group: 2614
Examiner: ALEXANDER JAMAL

BRIEF ON BEHALF OF APPELLANTS UNDER 37 CFR 41.37

Valerie M. Davis
Attorney of Record

Motorola, Inc.
Intellectual Property Section
Law Department
1303 E. Algonquin Rd.
Schaumburg, IL 60196

Telephone: 847-576-6733
Facsimile: 847-576-0721

Submittal Date: December 30, 2006

CONTENTS

I.	<u>REAL PARTY IN INTEREST</u>	3
II.	<u>RELATED APPEALS AND INTERFERENCES</u>	3
III.	<u>STATUS OF CLAIMS</u>	3
IV.	<u>STATUS OF AMENDMENTS</u>	3
V.	<u>SUMMARY OF CLAIMED SUBJECT MATTER</u>	4
VI.	<u>GROUND OF REJECTION TO BE REVIEWED ON APPEAL</u>	5
VII.	<u>ARGUMENT</u>	6
VIII.	<u>CLAIMS APPENDIX</u>	11
IX.	<u>EVIDENCE APPENDIX</u>	17
IX.	<u>RELATED PROCEEDINGS APPENDIX</u>	17

I. REAL PARTY IN INTEREST

The name of the real party in interest for purposes of this appeal is Motorola, Inc., a Delaware corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Applicant, the Applicant's legal representative, or assignee which would directly affect or be directly affected by or having a bearing on the Board's decision in this pending appeal.

III. STATUS OF CLAIMS

Claims 1-3, 5-8, 10-11 and 14-20 remain in the application. Claims 1-3, 5-8, 10-11 and 14-20 are being appealed. Claims 1-3, 5-8, 10-11 and 14-20 stand or fall together.

In a final Office Action dated September 6, 2006, the Examiner rejected Claims 1-3, 5-8, 10, 11, 14, 15 and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Reichelt, et al. (USPN 6,295,447) in view of Rabe, et al. (USPN 6,138,010) and rejected Claim 16 under 35 U.S.C. 103(a) as being unpatentable over Reichelt, et al. as applied to Claim 14, and further in view of Mangal (USPN 6,801,519).

IV. STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the Final Office Action mailed September 6, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Although specification citations are inserted below in accordance with 37 C.F.R. § 41.37, these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the brief. There is no intention to in any way suggest that the terms of the claims are limited to the examples in the specification.

Although, as demonstrated by the reference numerals and citations below, the claims are fully supported by the specification as required by law, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology, as is done here to comply with rule 41.37, does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the reference numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

The invention, as defined in independent Claim 1 and with reference to FIG. 1, is a single wireless communication system 100 comprising: a plurality of communication devices (105-108); a plurality of base stations (160) adapted to provide radio communication resources for use by the plurality of communication devices; a packet network for connecting the plurality of base stations; a service management agent (e.g., 185) associated with an individual communication device (e.g., 105) of the plurality of communication devices, the service management agent comprising software executing on a microprocessor and adapted to manage the provision in the single wireless communication system of different types of services from a plurality of service

providers to the individual communication device. (Specification page 4, line 11 to page5, line 11 and page 8, line 21 to page 9, line 26).

The invention, as defined in independent Claim 14 and with reference to FIGs. 6 and 7, is a method for a service management agent to facilitate the provision of services to a communication device comprising the steps of: receiving (710), by a service management agent associated with a communication device, a request by a first service provider of a plurality of service providers to provide in a single wireless communication system a first service to the communication device; determining (720), by the service management agent, whether the first service can be provided to the communication device, wherein the determining comprises determining whether a second different type of service is being provided in the single wireless communication network to the communication device from a second service provider of the plurality of service providers; and notifying (730), the first service provider whether the first service can be provided to the communication device. (Specification page 15, line 19 to page 16, line 17).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. Whether Claims 1-3, 5-8, 10, 11, 14, 15 and 17-20 are patentable under 35 U.S.C. 103(a) over Reichelt, et al. in view of Rabe, et al.?
- B. Whether Claim 16 is patentable under 35 U.S.C. 103(a) over Reichelt, et al. as applied to Claim 14, and further in view of Mangal?

VII. ARGUMENT

A. Claims 1-3, 5-8, 10, 11, 14, 15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichelt, et al. (USPN 6,295,447) in view of Rabe, et al. (USPN 6,138,010).

To establish a *prima facie* case of obviousness, and hence to find Claims 1-3, 5-8, 10, 11, 14, 15 and 17-20 unpatentable under 35 U.S.C. § 103(a) over the combination of Reichelt, et al. and Rabe, et al., three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based upon applicant's disclosure. MPEP at § 2142.

In the present case, all three criteria are not met because the combined teachings of Reichelt, et al. and Rabe, et al. references do not teach or suggest all of the claim limitations of independent Claims 1 and 14.

Turning first to the primary cited reference Reichelt, et al., this reference teaches a method and system in which a subscriber may subscribe to one or more features with a single telecommunications provider. The subscriber may turn "ON" all or a subset of the total set of features. Additionally, the subscriber may specify one or more parameters or conditions under which a given feature is to be executed. Therefore, when a call event occurs, the relevant telecommunications network evaluates a logical expression that includes variables corresponding to each of the specified conditions for execution of the feature. If the specified conditions are

such that the logical expression for the given feature is “TRUE” and the feature is “ON” then the network executes the feature. If one or more of the specified conditions are such that the logical expression is not “TRUE” or the given feature is not “ON”, then the network does not execute the feature. Col. 2, lines 37-58.

Claim 1 is directed to a single wireless communication system such as one disclosed in Reichelt, et al. However, Claim 1 includes limitations directed to a “service management agent associated with an individual communication device . . . [and] adapted to *manage the provision in the single wireless communication system of different types of services from a plurality of service providers* to the individual communication device”. Reichelt, et al. fails to disclose these limitations. Instead, this reference teaches managing a plurality of features provided by a single service provider in a single wireless network for execution on a device.

The Examiner concedes on page 3 of the Final Office Action that “Reichelt does not disclose that the [features] are from a plurality of service providers”. However, the Examiner argues that it is obvious to modify the Reichelt, et al. reference with the Rabe, et al. reference to reach the claimed invention. Applicants disagree. Applicants submit that the combination of Reichelt, et al. and Rabe, et al. do not render Claim 1 obvious because limitations are still missing from this combination.

Rabe, et al. teaches a communication device that is operable on a plurality of radio communication systems including a first communication system and a second communication system, wherein the first and second communication systems are autonomous from each other in that they are independent from and have no knowledge of each other and the communication device communicates independently with each system. Col. 2, lines 58-61 and col. 3, lines 8-17. To facilitate such communications, the device includes a system supervisor that provides control

for accessing the different communication systems available to the device by arbitrating usage of shares resources (e.g., a shared antenna, etc.) within the device. Col. 7, lines 33-42. Thus, Rabe, et al. teaches managing communications by a single communication device with different autonomous systems that provide the same service (i.e., radio service). This is not “*manag[ing] the provision in the single wireless communication system of different types of services from a plurality of service providers*” to the individual communication device” as is recited in Claim 1.

Therefore since limitations recited in Claim 1 and included by dependency in Claim 2-3 and 5-8 are missing from the combination of the Reichelt, et al. and Rabe, et al. references, a rejection of these claims under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Regarding Claim 14, there are a number of limitations that are missing from the combined teachings of Reichelt, et al. and Rabe, et al. First, Claim 14 recites “receiving, by a service management agent associated with a communication device, a request by a first service provider of a plurality of service providers to provide in a single wireless communication system a first service to the communication device”, which limitations are not disclosed in Reichelt, et al. The Examiner argues at page 3 of the Final Office Action that the service provider requests various services by “an action to trigger the ‘TRUE’ setting”. Applicants disagree. First, no action by the service provider triggers the ‘TRUE’ setting in the communication device. This setting is preset and merely evaluated by the network when a call event occurs.

Second, the crux of the invention disclosed in the Reichelt, et al. reference is that it “enables the invocation of the feature to be dependent on subscriber and/or operator *defined conditions*. Based on a given set of conditions, the subscriber and/or operator may *define one or more logical expressions that, when evaluated to “TRUE”, trigger the execution of the feature* with the specified action” col. 3, lines 54-62. Accordingly, whether a feature is provided is

determined solely by predefined conditions based on preset logical expressions in communication device. There is no need for a service management agent to receive a request from a service provider to provide features to the communication device. Whenever a call event occurs, the network either executes or does not execute certain features in the communication device based on those predefined conditions and preset logical expressions in the communication device. In addition, as argued above Reichelt, et al. teaches only one service provider in a single system. Therefore, it could not teach nor be modified to teach a request by a first of a plurality of service providers in a single wireless communication system as recited in Claim 14.

Claim 14 further recites the limitations of “determining, by the service management agent, whether the first service can be provided to the communication device, wherein the determining comprises *determining whether a second different type of service is being provided in the single wireless communication network to the communication device from a second service provider of the plurality of service providers*”. Since as discussed above neither Reichelt, et al. nor Rabe, et al. teach managing different types of services from different service providers in a single network, neither of these references can therefore teach the above-quoted limitations recited in Claim 14.

Therefore since limitations recited in Claim 14 and included by dependency in Claim 10-11, 15 and 17-20 are missing from the combination of the Reichelt, et al. and Rabe, et al. references, a rejection of these claims under 35 U.S.C. § 103(a) is improper and should be withdrawn.

B. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reichelt, et al. as applied to Claim 14, and further in view of Mangal (USPN 6,801,519).

Applicants have set forth a number of limitations that are recited in Claim 14 and included by dependency in Claim 16, which are not disclosed in the combined teachings of Reichelt, et al. and Rabe, et al. Applicants further submit that these limitations are also not disclosed in Mangal. Therefore, since limitations are missing from the combined teachings of the Reichelt, et al., Rabe, et al. and Mangal references, a rejection of Claim 16 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

For the reason set forth above, Applicants submit that the Examiner has incorrectly rejected Claims 1-3, 5-8, 10-11 and 14-20 under 35 U.S.C. § 103(a) and request that the Board withdraw the rejections.

Respectfully submitted,

Sanders III, et al.

by: /Valerie M. Davis/
Valerie M. Davis
Attorney for Applicant
Registration No. 50,203
Phone: (847) 576-6733
Fax: (847) 576-0721

VIII. CLAIMS APPENDIX

1. (previously presented) A single wireless communication system comprising:
 - a plurality of communication devices;
 - a plurality of base stations adapted to provide radio communication resources for use by the plurality of communication devices;
 - a packet network for connecting the plurality of base stations;
 - a service management agent associated with an individual communication device of the plurality of communication devices, the service management agent comprising software executing on a microprocessor and adapted to manage the provision in the single wireless communication system of different types of services from a plurality of service providers to the individual communication device.
2. (original) The wireless communication system of claim 1 wherein the service management agent is co-located with the individual communication device.
3. (original) The wireless communication system of claim 1 wherein the service management agent is co-located with a device of the packet network.
4. (cancelled)
5. (original) The wireless communication system of claim 1 wherein the service management agent is co-located with one of the plurality of base stations.

6. (previously presented) The wireless communication system of claim 1 wherein the service management agent is a first service management agent and the individual communication device is a first communication device, the single wireless communication system further comprising:
 - a second service management agent associated with a second communication device of the plurality of communication devices and adapted to manage the provision in the single wireless communication system of the different types of services from the plurality of service providers to the second communication device.
7. (original) The wireless communication system of claim 6 wherein the first service management agent and the second service management agent are in different locations.
8. (original) The wireless communication network of claim 6 wherein the first service management agent and the second service management agent are co-located.
9. (cancelled)
10. (previously presented) The method of claim 14 wherein the step of determining whether the first service can be provided to the communication device comprises:
 - making a positive determination if no other service provider is currently providing another service to the communication device; and
 - making a negative determination if another service provider is currently providing another service to the communication device.

11. (previously presented) The method of claim 14 wherein the step of determining whether the first service can be provided to the communication device comprises the steps of:

determining that the second service is being provided to the communication device;

consulting, by the service management agent, a service criteria for the communication device;

determining, from the service criteria whether the first or second service has priority; and

if the first service has priority, interrupting the second service.

12. (cancelled)

13. (cancelled)

14. (previously presented) A method for a service management agent to facilitate the provision of services to a communication device comprising the steps of:

receiving, by a service management agent associated with a communication device, a request by a first service provider of a plurality of service providers to provide in a single wireless communication system a first service to the communication device;

determining, by the service management agent, whether the first service can be provided to the communication device, wherein the determining comprises determining whether a second different type of service is being provided in the single wireless communication network to the communication device from a second service provider of the plurality of service providers; and

notifying, the first service provider whether the first service can be provided to the communication device.

15. (previously presented) The method of claim 14 wherein if the second service is not being provided to the communication device, determining that the first service can be provided to the communication device.

16. (original) The method of claim 14 wherein the communication device has a characteristic bandwidth and the step of determining comprises the step of:

adding the bandwidth required for the first service to the bandwidth required for any other services being provided to the communication device to obtain a total bandwidth; and

if the total bandwidth is less than the characteristic bandwidth of the communication device, making the determination that the first service can be provided to the communication device.

17. (previously presented) The method of claim 14 wherein the step of determining whether the first service can be provided to the communication device further comprises the steps of:

determining, by the service management agent that the second service is being provided to the communication device by the second service provider;

notifying the communication device, by the service management agent, that the first service provider requests to provide the first service to the communication device;

responsive to a reply from the communication device, determining that the first service can be provided to the communication device.

18. (original) The method of claim 17 further including the step of:
- notifying the second service provider, by the service management agent,
that the second service provider should stop providing the second service to
the communication device.
19. (previously presented) The method of claim 14 wherein the first service and the second service are selected from the group consisting of telephone calls, dispatch calls, pages and electronic mail.
20. (previously presented) The method of claim 14 wherein the step of determining whether the first service can be provided to the communication device further comprises the steps of:
- determining, by the service management agent that the second service is
being provided to the communication device by the second service provider;
waiting, until the second service is no longer being provided to the
communication device by the second service provider; and
determining, by the service management, agent that the first service can be
provided to the communication device when the second service is no longer
being provided to the communication device.

IX. EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, entered by the examiner and relied upon by the appellant in the appeal, or relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

X. RELATED PROCEEDINGS APPENDIX

No decisions have been rendered by a court of the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. § 41.37.